

REMARKS

The Office Action and cited references have been reviewed. Claims 1- 32 are pending in this application, have been rejected, and are at issue herein. Claims 1, 15, and 32 have been amended to further define the invention. Claim 19 has been amended to correct an antecedent basis. This amendment does not reduce the scope of the claim. Reconsideration of claims 1-32 and indication of the allowance thereof are respectfully solicited.

35 U.S.C. § 112 Rejection

The Examiner has rejected claim 13 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description. The Examiner has stated that there is not a written description of the claimed limitation in the application as filed.

The Examiner has rejected the originally filed claims under the first paragraph of 35 U.S.C. § 112 for failing to contain an adequate written description of the invention claimed. However, as has been consistently held by the Federal Circuit, originally filed claims provide their own written description support under 35 U.S.C. § 112, first paragraph. See *Atmal Corp. v. Information Storage Devices, Inc.*, 198 F.3d 1374, 53 USPQ2d 1225 (Fed. Cir. 1999) (citing *In re Gardner* 480 F.2d 879, 880, 178 USPQ 149 (CCPA 1973) ("under these circumstances, we consider the original claim in itself adequate 'written description' of the claimed invention. It was equally a 'written description' . . . whether located among the original claims or in the descriptive part of the specification."). Further, the "Guidelines for Examination of Patent Applications under 35 U.S.C. § 112, paragraph 1, "Written Description" requirement listed in the FEDERAL REGISTER, January 5, 2001 (Vol. 66, No. 4), pages 1099-1111, states "there is a strong presumption that an adequate written description of the claimed invention is present when the application is filed." While recognizing that there may be situations where the original claims do not provide an adequate written description of the claimed invention, this USPTO publication points out that this problem typically arises:

where an invention is described solely in terms of a method of its making coupled with its function and there is no described or art-recognized correlation or relationship between the structure of the invention and its function. A lack of adequate written description issue also arises if the knowledge and level of skill in the art would not permit one skilled in the art to immediately envisage the product claimed from the disclosed process.

Clearly, the invention as claimed in the instant application does not fit either of these examples.

In view of the Federal Circuit case law, the USPTO's own examination guidelines for the written description requirement, the Applicants respectfully submit that the Examiner has stated no reasons why the "strong presumption" that the original claims provide an adequate written description of the invention so claimed is overcome. Further, the Applicants refer the Examiner to the originally filed specification on page 19, lines 10-14, which describes these very features. As such, the Applicants respectfully submit that this ground of rejection is erroneous and should be removed. Reconsideration of this ground of rejection in view of the foregoing comments and allowance thereof are therefore respectfully solicited.

35 U.S.C. §103 Rejections

To establish a prima facie case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one skilled in the art, to modify the reference or combine teachings. Any proposed modification cannot render the prior art unsatisfactory for its intended purpose or change the principle of operation of a reference. There must be a reasonable expectation of success and the prior art references must teach or suggest all of the claim limitations. See M.P.E.P. 2143. Conclusory statements cannot be relied on when dealing with particular combinations of prior art and specific claims. The rationale for combining references must be put forth. *In re Lee*, 61 U.S.P.Q.2d 1430, 1433. The Examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge

generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references".

The Examiner has rejected claims 1-4, 6, 10, 11, 13-23 and 30-32 under 35 U.S.C. § 103(a) as being unpatentable over Nguyen et al. (U.S. Patent No. 6,412,021) in view of Badt et al. (U.S. Patent No. 6,542,868). This ground of rejection is believed overcome by the above amendments to claims 1 and 15. Reconsideration of this ground of rejection and allowance of claims 1-4, 6, 10, 11, 13-23 and 30-32 in view of the foregoing amendments and the following remarks are respectfully solicited.

Claims 1 and 15 have been amended to point out that a notification component receives notifications from a plurality of objects. This is described in the instant specification and illustrated in Figure 2 of the present invention. The notification component receives notifications from a plurality of objects, determines a notification type and a priority specified by the user, and renders the notification in accordance with the notification type and the priority. As explained in the present specification, the user specifies the priority of how notifications are rendered. The priorities that are specified include which notification classifications have priority over other notification classifications and how often the notification component should notify the user.

The Examiner correctly states that the event of Nguyen et al. is not assigned a priority in accordance with a user specified priority. The Examiner has previously stated that Nguyen et al. teaches that an event is placed on the event queue because the events in queue are processed in a first-in-first-out sequence. This queued priority is not based upon a user's specified priority. Badt et al. teaches setting a priority level for each notification arriving into a queue and rendering audio notifications in accordance with the priority level. Badt et al. also teaches interrupting a notification in progress if a higher priority notification is received. Modifying Nguyen et al. to interrupt notifications if a higher priority level is received changes the principle of operation of Nguyen et al., which the M.P.E.P. prohibits - see M.P.E.P. § 2143.01.

Furthermore, Badt et al. teaches that an audio-only interface receives notifications that are to be rendered with an audio notification. The audio-only interface of Badt et al. does not receive notifications of types other than audio notifications and therefore cannot receive notifications of different types as required by claims 1 and 15. Nguyen et al. teaches that

independent notification classes embodied as threads are designated for each applet to use, one notification class for each applet, to provide notifications for the applet. As a result, the independent notification classes do not receive notifications from a plurality of objects (e.g., applets). Therefore, neither Nguyen et al. nor Badt et al., singly or in combination, teach all of the elements of claims 1 and 15.

In view of the foregoing, it is respectfully requested that the Examiner withdraw the rejection of claims 1 and 15.

Claims 2-4, 6, 10, 11, and 13-14 depend from claim 1 and are believed to be patentable for the same reasons set forth above for claim 1. Claims 16-23 and 30-32 depend from claim 15 and are believed to be patentable for the same reasons set forth above for claim 15.

With respect to claim 13, the Examiner states that the number of times the user is provided notification is based comparing the notification priorities if a new notification is a repeat notification. The Applicants respectfully disagree. Claim 13 requires the step of determining the number of times a particular notification is provided to the user. Receiving a new notification that is a repeat notification and comparing the notification priority does not determine the number of times that the user is provided a particular notification. Rather, it determines when the notification is rendered. Nguyen et al. and Badt et al. have been reviewed and no teaching or suggestion, singly or in combination, could be found of determining a number of times the user is provided a notification.

With respect to claims 14 and 17, the Examiner states that Nguyen et al. teaches the elements of claims 14 and 17. Specifically, the Examiner states that column 4, lines 38-52 teach checking a user preference list to see if the notification classification is listed in a list of selected classifications selected by the user to indicate which notification classifications the user wants to receive and rendering the notification if the notification class is listed in the list of selected classifications. The Applicants respectfully disagree. Column 4, lines 38-52 of Nguyen et al. teach checking a configuration file to see what button icons should be displayed in a selection bar. As described in the instant specification, a notification classification is a category of notifications, which may include a contact classification, a financial classification, an e-mail classification, and an audio classification. It is respectfully submitted that a button icon is not a notification classification as the term is defined in the

instant specification and required by claim 14 and does not teach rendering the notification in accordance with a user preference as required by claim 17. Therefore, it is respectfully submitted that Nguyen et al., nor Badt et al., singly or in combination, do not teach or suggest checking a user preference list to see if the notification classification is listed in a list of selected classifications selected by the user to indicate which notification the classifications the user wants to receive and rendering the notification if the notification class is listed in the list of selected classifications or rendering the notification in accordance with a user preference.

With respect to claim 18, the Examiner states that notification events are enabled and non-notification events are disabled. Nguyen et al. and Badt et al. have been thoroughly reviewed and no teaching or suggestion could be found of a non-notification event. It is respectfully submitted that the Examiner is adding to Nguyen et al. and Badt et al. elements that are not taught or even remotely suggested in the cited references. For example, Nguyen et al. teaches that the response entails one or more forms of user notification, including changing a button icon in a selection bar, setting a fixed or flashing glyph on the button icon, displaying a message in a dialog box, or playing an audio clip. The above teaches that the user is always notified of an event. Similarly, Badt et al. teaches that once a notification is selected, a message corresponding to the selected notification is played to the user. Claim 18, on the other hand, requires that the classification enable of a notification classification be enabled in order for the notification to be rendered. This means that the user is not always provided the notification. Therefore, it is respectfully submitted that Nguyen et al. and Badt et al. do not teach or suggest, singly or in combination, a classification enable of a notification classification be enabled in order for the notification to be rendered. Furthermore, it is respectfully submitted that Nguyen et al. teaches away from requiring that a classification enable of a notification classification be enabled in order for the notification to be rendered.

With respect to claim 21, the Examiner states that Nguyen et al. as modified teaches sending a pre-notification notification prior to rendering the notification if the notification is an audio notification and points to column 2, lines 5-15 of Badt et al. Badt et al. teaches sending a notification to the user to determine if the message corresponding to the notification should be played. If the user does not want to hear the message, the notification

is not played. This teaches that the notification is not always rendered. Claim 21 requires that the notification always be rendered.

With respect to claim 32, the Examiner states that Nguyen et al. teaches a long version (a message in a dialog box) and a short version (method to display updated clock images on the associated button icon) and points to column 13, lines 35-50 of Nguyen et al. for support. As required in claim 32, the short version is an abbreviated version of the long version of the same notification. For example, the long version of a notification could be "Microsoft up 2 at 82 on increased volume" and a short version of the notification could be "Microsoft up 2 at 82." The rendering styles the Examiner is referring to in Nguyen et al. do not teach or suggest a long version and a short version of a notification.

In view of the foregoing, it is respectfully requested that the Examiner withdraw the rejection of claims 2-4, 6, 10, 11, 13-14, 16-23, and 30-32.

The Examiner has rejected claim 9 under 35 U.S.C. § 103 as being unpatentable over Nguyen et al. and Badt et al. in view of U.S. Patent No. 6,144,942 to Ruckdashel. Claim 9 is believed to be patentable for the reasons set forth above and for claim 1. Therefore, it is respectfully requested that the rejection of claim 9 be withdrawn.

The Examiner has rejected claims 12 and 26-29 under 35 U.S.C. § 103 as being unpatentable over Nguyen et al. and Badt et al. in view of U.S. Patent No. 5,950,211 to Shealy. Claims 12 and 26-29 are believed to be patentable for the same reasons set forth above and for claims 1 and 15.

With respect to claims 12 and 27, Shealy teaches logging an event when a queue is flushed. Claim 27 requires flushing read items from the history that have been read by a user and flushing old items from the history based upon user preferences. It is respectfully submitted that logging an event when a queue is flushed or flushing messages in a given priority is not the same as and does not suggest flushing items from a history after they have been read or flushing old items determined from the user preference. Therefore, neither Nguyen et al. nor Shealy, singly or in combination, teach or suggest all of the limitations of claims 12 and 27.

With respect to claims 28, claim 28 depends from claim 27 and is believed to be patentable for the same reasons put forth above for claim 27. Furthermore, claim 28 requires that items in the history be displayed in accordance with the user preference. Shealy teaches

using the utility 90 to obtain history log information in the form of a report. No teaching could be found of displaying items in the report in accordance with a user preference. Therefore, neither Nguyen et al. nor Shealy, singly or in combination, teach or suggest all of the limitations of claim 27.

With respect to claim 29, it requires the steps of displaying the history and performing at least one action if a notification in the history is selected by a user selection device. Shealy teaches using the utility to obtain history information in the form of a report. Shealy also teaches using the utility to configure a device driver and to process collected information. Configuring a device driver and collecting information are performed without selecting a notification in the report of Shealy. No teaching or suggestion could be found in either Nguyen et al. or Shealy of performing an action if a notification in the history is selected by a user selection device.

Furthermore, it is respectfully submitted that the stated reasons for the Examiner's reason to combine references is a conclusory statement that is prohibited by *In re Lee*. A person skilled in the art would have no reason to look at Shealy in view of Nguyen et al. because Nguyen et al. does not teach or suggest flushing a queue and would therefore not look elsewhere to determine how to perform a user notification using the teachings or suggestions of Nguyen et al.

Therefore, in view of the foregoing, it is respectfully requested that the rejection of claims 12 and 26-29 be withdrawn.

The Examiner has rejected claim 5 under 35 U.S.C. § 103 as being unpatentable over Nguyen et al. and Badt et al. in view of U.S. Patent No. 6,405,204 to Baker et al. Claim 5 is believed to be patentable for the same reasons set forth above and for claim 1.

Furthermore, Nguyen et al. is directed to a method and apparatus for performing notifications for applets that may or may not be loaded into memory. Baker et al. is directed to system that provides index performance alerts based upon price performance measures of each industry, sector, sub-sector, or group. The alerts are provided via standard e-mail as well as XML using push technology. It is respectfully submitted that Baker et al. is non-analogous art because an inventor looking to provide notifications for applets that may not be loaded in memory would not look to art that is directed to financial alerts. Additionally, it is respectfully submitted that the Examiner's stated reason for combining the references is not

related in any way to the problem being solved in Nguyen et al., and therefore, a person skilled in the art would not look to combine the Nguyen et al. and Baker et al. references. Therefore, it is respectfully submitted that the Examiner withdraw the rejection of claim 5.

The Examiner has rejected claims 7, 8, 24, and 25 under 35 U.S.C. § 103 as being unpatentable over Nguyen et al. and Badt et al. in view of U.S. Patent No. 6,317,128 to Harrison et al. Claims 7, 8, 24, and 25 are believed to be patentable for the same reasons set forth above and for claims 1 and 15.

With respect to claims 7 and 24, the Examiner states that Nguyen et al. teaches a flashing glyph and a fixed glyph on the button icon and a transient display. For support of stating that Nguyen et al. teaches a transient display, the Examiner notes that that dialog boxes are generally transient. The Applicants respectfully disagree. A dialog box is displayed until the user selects a button to dismiss the dialog box. As such, a dialog box is displayed for as long as the user desires, including for as long as the user's machine is powered. Therefore, a dialog box is not a transient display. Therefore, it is respectfully submitted that Nguyen et al. does not teach or suggest an alpha-blended display or a transient display. Furthermore, the Applicants respectfully submit that the Examiner has made conclusory statements in the § 103 rejections and has put forth no rationale as to why one of ordinary skill in the art would combine the references. The Examiner has only stated what the Examiner believes the references teach and that it would be obvious to combine the references based on what Harrison et al. teaches. It is respectfully submitted that the Examiner's stated reason for combining the references is not related in any way to the problem being solved in Nguyen et al., and therefore, a person skilled in the art would not look to combine the Nguyen et al. and Harrison et al. references. The Applicants respectfully submit that a prima facie case of obviousness has not been made. Therefore, it is respectfully submitted that the Examiner withdraw the rejection of claims 7, 8, 24, and 25.


Conclusion

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the

In re Appln. of Felix G.T.I. Andrew et al.
Application No. 09/705,858

Examiner, a telephone conference would expedite the prosecution of the subject application,
the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

A handwritten signature in cursive script, reading "Kevin L. Wingate".

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